



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,079	11/02/2001	Chaitanya Kanojia	2657.2008-001	5364
21005      7590      08/07/2006 HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			EXAMINER SALCE, JASON P	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/003,079		KANOJIA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Jason P. Salce		2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-10 is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/01 and 11/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 6/9/2006 have been fully considered but they are not persuasive.

The amended claims still read on the prior art of record (see rejection below).

### ***Claim Objections***

2. Claim 6 is objected to because of the following informalities: In Line 2, the limitation "promotional message" should read "promotional content stream".  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins (U.S. Patent No. 5,446,919) in view of Schulman (U.S. Patent No. 5,600,366).

Referring to claim 1, Wilkins discloses in a cable television network system that connects STBs to receive broadcast program content from cable network head end distribution points (see Figure 1A-1B and Column 8, Lines 42-67 for transmitting the program content over the distribution network and Column 10, Lines 16-18 for the STB

receiving the program content), a method for delivery of a promotional content stream to the STBs (see Figure 4 and Column 12, Lines 27-40).

Wilkins also discloses cueing a promotional content stream at a VOD server (see Column 9, Lines 50-55 and VTR 41 and 42) to be played on a VOD channel for a particular STB (see Column 9, Lines 55-65 for modulating the promotional content onto the proper RF channel and transmitting the promotional content to the viewer's home, which contains STB 100 in Figure 2), the VOD server located at a cable network headend (see central processor 32 located at the cable television headend in Figure 1B).

Wilkins also discloses sending a first trigger to the particular STB indicating the VOD channel number (see Column 11, Lines 27-38 for transmitting a trigger which indicates channels that can be tuned to based on the user's demographic group (stored in STB 100 in Figure 2)), but which does not cause the STB to yet switch to the VOD channel (see Column 11, Lines 27-28 for the trigger being transmitted prior to the commercial starting, therefore the first trigger does not switch to the VOD channel, but only provides the information to make the determination to switch to the specified VOD channel).

Wilkins also discloses sending (from the headend distribution point) a second tune away trigger to cause the STB to immediately switch to the VOD channel indicated by the first trigger (see Column 12, Lines 11-16 for the set top box comparing the tag to the stored profile command data in order to make a determination and trigger the set top box to switch to an alternate commercial).

Wilkins also discloses beginning playback of the promotional content stream (see Column 12, Lines 45-59).

Wilkins also discloses sensing the second trigger in a broadcast channel being watched at the STB, the second trigger signal indicating an upcoming start of a commercial segment (see Column 12, Lines 10-11 where at the time of broadcast a tag is transmitted, which indicates the start of a commercial (also note Column 12, Lines 27-40 for implementing the tag system in the current advertisement switching system)), however, Wilkins is silent about sensing a commercial cue tone signal in a broadcast channel at a head end distribution point, the commercial cue tone indicating an upcoming start of the commercial segment, in other words, Wilkins does not disclose how the head end knows when to transmit the second trigger to the viewer to inhibit the STB to change the channel to the alternative television channel (where the promotional content resides).

Schulman discloses the use of commercial cue tones to detect the start of a video segment and display alternative commercials to the viewer (see Column 7, Lines 23-41).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the tags, as taught by Wilkins, using the commercial cue tones, as taught by Schulman, for the purpose of providing a system where switching occurs predictably at the end of packets and frames so that undesired error states are not encountered (see Column 5, Lines 11-13 of Schulman).

Claim 2 corresponds to claim 1, where Wilkins also discloses that the STB stores a channel number being watched prior to playback of the promotional content stream, and returns to the stored channel number once the promotional content stream ends (see Column 13, Lines 66-67 and Column 14, Lines 1-2 for storing a channel to tune to when a commercial is to be viewed and a channel to return to after the commercial has been viewed).

Claim 3 corresponds to claim 1, where Schulman further discloses that pixilation that may occur during channel switchover to the VOD channel is blanked at the STB (see Column 7, Lines 52-64).

Claim 5 corresponds to claim 1, where Wilkins further discloses that before the step of sending a first trigger, receiving at the headend, a promotion schedule message for each expected instantiation of an expected promotion play back at each STB (see Column 8, Lines 11-14).

Claim 6 corresponds to claim 1, where Wilkins further discloses that after the step of cuing a promotional content stream, at the VOD server, returning a message indicating an expected VOD channel number (see Column 9, Lines 50-55 for cueing the promotional content stream from VTR 44 and inserting selection profile/instructions into the VBI of the signal).

Art Unit: 2623

Claim 7 corresponds to claim 1, where Wilkins further discloses that the second trigger is sent over the VBI in a broadcast stream (see Column 10, Lines 6-7).

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins (U.S. Patent No. 5,446,919) in view of Schulman (U.S. Patent No. 5,600,366) in further view of Tsuria (U.S. Patent No. 5,786,845).

Referring to claim 4, Wilkins and Schulman disclose all of the limitations in claim 1, but fail to teach that channel information is displayed during switchover to the VOD channel.

Tsuria discloses displaying channel information (an advertisement for the channel) during a switchover to the television channel (see Column 3, Line 60 through Column 4, Line 6). Note that Wilkins and Schulman both disclose a VOD channel (see rejections above), and note that a VOD channel is part of a CATV system, taught by Tsuria.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the television switchover system, as taught by Wilkins and Schulman, using the channel information display system during a channel change, as taught by Tsuria, for the purpose of providing additional services which are especially applicable for use at zapping times (see Column 1, Lines 32-33 of Tsuria), and providing advertising during lag time between channel changes so that the viewer is not discouraged from using the system.

***Allowable Subject Matter***

5. Claims 8-10 are allowed.

The following is an examiner's statement of reasons for allowance:

In regards to independent claim 8, the prior art of record fails to anticipate or rendered obvious the combined elements/steps of, "sending a message to the VOD server, the message requesting playback of the promotion" and "receiving, from the VOD server, an indication of a VOD channel number on which the indicated promotion will be played" and "the message including an identifier for the promotion to be returned to the head end message server after the promotion is played back at the STB".

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

The examiner further notes that Wilkins fails to teach a VOD server for receiving and sending messages and indications specifying the channel number of the promotion and that demographic/psychographic information encoder 12 in Figure 1B provides this information to the channel selection decoder 100 (see Column 9, Lines 31-33). Note that VTR 51 or VTR 52 along with the selection profile vertical interval encoder 51 and 52, respectively, only teach local alternative commercial to transmit to the viewer (see Column 9, Lines 47-59) and do not receive specific messages to request playback.

***Conclusion***



**6. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

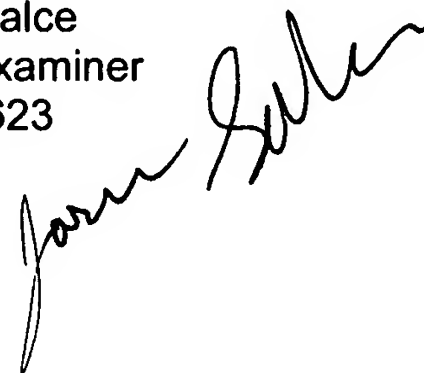
**7.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce  
Primary Examiner  
Art Unit 2623

A handwritten signature in black ink, appearing to read "Jason Salce", written diagonally across the printed name and title.

August 1, 2006